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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,062	12/14/2001	Toshihisa Matsuo	70904/56790	5485

7590

07/27/2005

David A Tucker
Edwards & Angell LLP
P O Box 55874
Boston, MA 02205

EXAMINER

TABATABAI, ABOLFAZL

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,062

Applicant(s)

MATSUO, TOSHIHISA

Examiner

Abolfazl Tabatabai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Final Action

Response to Amendments/Arguments

1. Applicant's arguments, see (pages 9-13), filed May 12, 2005, with respect to the rejection(s) of claims 1-9 under Miyashita et al (U S 6,753,160 B1) and Ueki (U S 6,678,236 B1) have been fully considered and are not persuasive. Therefore, This Office Action Made Final.
2. Applicant argues in essence that the prior art does not teach or suggest embedding of copyright information in the main information. Examiner disagrees and indicates that , Miyashita teaches embedding of copyright information in the main information (see column 7, lines 22-33).
3. Applicant argues in essence that the prior art does not teach or suggest the presence of watermarking of any type. Examiner disagrees and indicates that Miyashita teaches watermarking (see column 17, lines 11-21).
4. Applicant argues in essence that the prior art does not teach or suggest no watermarking is embedded in the main information. Examiner disagrees and indicates that Miyashita teaches watermarking is embedded in the main information (see column 17, lines 11-21).
5. Applicant argues in essence that the prior art does not teach or suggest that each pitch is to have a depth formed according to the additional information. Examiner disagrees and indicates that Ueki teaches each pit is to have a depth formed (see column 2, lines 40-53 and column 10, lines 2-25).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 11, 12, 14, 16-18, 20, 22-24, 26 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyashita et al (U S 6,735,160 B1).

Regarding claim 11, Miyashita discloses an optical recording medium wherein main information is recorded on the optical recording medium (fig. 2 element 100; Column 15, lines 63-67 and column 24, lines 15-18), and the main information having digital watermarking embedded therein, such that copying of the main information also copies the digital watermarking (column 7, lines 22-33; column 5, lines 12-15 and column 11, lines 41-52), the digital watermarking indicating copyright information (column 11, lines 50-52), and additional information is formed on the optical recording medium, such that the additional information cannot be copied (column 10, Lines 3-10).

Regarding claim 12, Miyashita discloses an optical recording medium according

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to claim 11, wherein the additional information is formed by a plurality of pits (column 10, lines 3-10), each pit having a depth formed according to the additional information (Column 24, lines 54-64).

Regarding claim 14, Miyashita discloses the optical recording medium according to claim 11, wherein the additional information is formed by pits 9column 10, lines 3-10), and the pits are formed at a position shifted from a regular pit position in a track direction according to the additional information (column 17, lines 58-67 and column 20, lines 27-36).

Regarding claim 16, Miyashita discloses the optical recording medium of claim 11, wherein the additional information indicates that the recording medium is original (Column 16, lines 55-63).

Regarding claim 17 Miyashita discloses the a reproducing apparatus comprising:

reproducing means for reproducing an optical recording medium having main information stored thereon (column 23, lines 45-49 and 57-60); and,

reproduction restricting means for determining whether additional information is

formed on the optical recording medium and determining whether digital watermarking is embedded in the main information (column 5, lines 12-21), the reproduction restricting means restricting reproduction of the main information if it is determined that (column 5, lines 3-11):

(i) digital watermarking is embedded in the main information (column 7, lines 22-33), and

(ii) additional information indicating that the recording medium is original is not formed on the optical recording medium (column 24, lines 15-18).

Claim 18 is similarly analyzed as claim 12 above.

Claim 20 is similarly analyzed as claim 14 above.

Claim 22 is similarly analyzed as claim 16 above.

Claim 23 is similarly analyzed as claim 17 above.

Claim 24 is similarly analyzed as claim 12 above.

Claim 26 is similarly analyzed as claim 14 above.

Claim 28 is similarly analyzed as claim 16 above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 13, 15, 19, 21, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita et al (U S 6,735,160 B1) in view of Ueki (U S 6,678,236 B1).

Regarding claim 13, Miyashita is silent about the specific details regarding discloses the optical recording medium according to claim 12, wherein the pits include a first pit having a first depth and a second pit having a second depth, and when a wavelength of a reproduction light beam is λ and a refractive index of the optical recording medium is n , the first depth is less than $\lambda/4n$, and the second depth exceeds $\lambda/4n$.

In the same field of endeavor (information recording system), however, Ueki discloses information recording medium system for recording and reproducing information comprising the pits include a first pit having a first depth and a second pit having a second depth, and when a wavelength of a reproduction light beam is λ and a refractive index of the optical recording medium is n , the first depth is less than $\lambda/4n$, and the second depth exceeds $\lambda/4n$ (column 10, lines 2-25).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use depth of pits as taught by Ueki in the system of Miyashita because Ueki provides Miyashita an improved system for recording information on a recording medium wherein the predetermined information comprises information of

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copyright protection related to the contents information stored in the data area and also an improved system for reproducing information from a recording medium.

Regarding claim 15, Miyashita is silent about the specifics details regarding the optical recording medium of claim 11, wherein the optical recording medium includes a plurality of regions, each region having an error correcting code associated therewith, such that the main information is error corrected using the error correction code to generate reproduction main information, and the additional information is formed by a difference between the reproduction main information and the main data recorded on the optical recording medium.

In the same field of endeavor (information recording system), however, Ueki discloses information recording medium system for recording and reproducing information comprises includes a plurality of regions, each region having an error correcting code associated therewith, such that the main information is error corrected using the error correction code to generate reproduction main information (column 10, lines 33-50 and column 11, lines 34-39), and the additional information is formed by a difference between the reproductions main information and the main data recorded on the optical recording medium (column 13, lines 22-24).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use error correcting code as taught by Ueki in the system of Miyashita because Ueki provides Miyashita an improved system for recording information on a recording medium wherein the predetermined information comprises information of copyright protection related to the contents information stored in the data area and also an improved system for reproducing information from a recording medium.

Claim 19 is similarly analyzed as claim 13 above.

Claim 21 is similarly analyzed as claim 15 above.

Claim 25 is similarly analyzed as claim 13 above.

Claim 27 is similarly analyzed as claim 15 above.

Other prior art cited

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent (U S 6,252,685 B1) to Yokochi is cited for optical recording medium and apparatus of judging fake thereof.

U.S. Patent (U S 6,338,889 B1) to Shibata et al is cited for optical information recording medium.

U. S. Patent (U S 6,580,682 B1) to Kamperman et al is cited for system for copy protection of recorded information.

U. S. Patent (U S 5,838,658) to Nakane et al is cited for optical disc.

U. S. Patent (U S 4,569,038) to Nagashima et al is cited for optical disk, high density optical disk system, and high density recording/ reproducing method using the optical disk.

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

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12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to ABOLFAZL TABATABAI whose telephone number is (571) 272-7458.

The Examiner can normally be reached on Monday through Friday from 9:30 a.m. to 7:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Mehta Bhavesh M, can be reached at (571) 272-7453. The fax phone number for organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abolfazl Tabatabai

Patent Examiner

Group Art Unit 2625

July 24, 2005

A-Tabatabai


KANUBHAI PATEL
PRIMARY EXAMINER